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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
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| 09/737,616 | 12/15/2000 | Sundeeb Bhan | 258/282 | 7989 |

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PROSKAUER ROSE LLP
PATENT DEPARTMENT
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EXAMINER

DURAN, ARTHUR D

ART UNIT PAPER NUMBER

3622

DATE MAILED: 09/28/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/737,616

Applicant(s)

BHAN ET AL. 

Examiner

Arthur Duran

Art Unit

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 25 June 2004.
2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-21 is/are pending in the application.
4a) Of the above claim(s) _____ is/are withdrawn from consideration.
5) ☐ Claim(s) _____ is/are allowed.
6) ☒ Claim(s) 1-21 is/are rejected.
7) ☐ Claim(s) _____ is/are objected to.
8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____.
4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____.
5) ☐ Notice of Informal Patent Application (PTO-152)
6) ☐ Other: _____.

DETAILED ACTION

1. Claims 1-21 have been examined.

Response to Amendment

2. The Amendment filed on 6/25/04 is sufficient to overcome the Von Kohorn reference.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

3. Claims 1, 13, 16 are rejected under 35 U.S.C. 103(a) as being unpatentable over Von Kohorn (5,759,101) in view of Goldhaber (5,794,210).

Von Kohorn discloses presenting material that promotes products and/or services (col 3, lines 44-46). Von Kohorn discloses presenting questions to users (col 3, lines 56-57).

Von Kohorn further discloses requiring a certain number of correct answers from users (col 3, line 45-col 4, line 40).

Von Kohorn further discloses that questions and answers can be presented in different time intervals (col 3, lines 5-15).

Goldhaber discloses presenting questions to users wherein the questions test whether the material presented in the material presenting step has been absorbed by the user (col 11, lines 30-44; col 16, lines 9-17; Fig. 3; col 23, lines 1-5; col 26, lines 52-59).

Goldhaber further discloses the utilization of URLs, webpages, and the Internet (col 8, lines 50-55; Fig. 12; col 3, lines 40-50).

Goldhaber further discloses the user being able to search or select specific items of interest (col 8, lines 40-50).

Goldhaber further discloses providing advertising content via a printed, tangible object (col 1, lines 50-66) and the utilization of email (col 20, lines 57-62).

Furthermore, it would be obvious to one skilled in the art that Goldhaber can invite the user to visit a website (col 21, lines 30-45; col 8, lines 50-60; col 8, lines 4-19).

Furthermore, since Goldhaber discloses printing advertisements and email, it would be obvious to one skilled in the art that the invitation to a website can be on a printed, tangible format or utilize email.

Furthermore, since the products are specifically identified, it would be obvious to one skilled in the art that product codes can be utilized.

Furthermore, since Goldhaber discloses a test, it would be obvious to one skilled in the art that the test can be multiple choice.

Furthermore, since Von Kohorn and Goldhaber disclose a test with correct answers, it would be obvious to one skilled in the art that variety of percentage of correct answers could be required to determine that the user paid sufficient attention.

Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made to add Goldhaber's rewarding a user for paying attention to content after testing the user to Von Kohorn's rewarding a user after testing and a user being presented

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content. One would have been motivated to do this in order to better determine that the user paid sufficient attention to advertising.

4. Claims 2-12, 14, 15, 17-21 are rejected under 35 U.S.C. 103(a) as being unpatentable over Von Kohorn (5,759,101) in view of Goldhaber (5,794,210).

Von Kohorn discloses presenting material that promotes products and/or services (col 3, lines 44-46). Von Kohorn discloses presenting questions to users (col 3, lines 56-57).

Von Kohorn further discloses requiring a certain number of correct answers from users (col 3, line 45-col 4, line 40).

Von Kohorn further discloses that questions and answers can be presented in different time intervals (col 3, lines 5-15).

Goldhaber discloses presenting questions to users wherein the questions test whether the material presented in the material presenting step has been absorbed by the user (col 11, lines 30-44; col 16, lines 9-17; Fig. 3; col 23, lines 1-5; col 26, lines 52-59).

Goldhaber further discloses the utilization of URLs, webpages, and the Internet (col 8, lines 50-55; Fig. 12; col 3, lines 40-50).

Goldhaber further discloses the user being able to search or select specific items of interest (col 8, lines 40-50).

Goldhaber further discloses providing advertising content via a printed, tangible object (col 1, lines 50-66) and the utilization of email (col 20, lines 57-62).

Furthermore, it would be obvious to one skilled in the art that Goldhaber can invite the user to visit a website (col 21, lines 30-45; col 8, lines 50-60; col 8, lines 4-19).

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Furthermore, since Goldhaber discloses printing advertisements and email, it would be obvious to one skilled in the art that the invitation to a website can be on a printed, tangible format or utilize email.

Furthermore, since the products are specifically identified, it would be obvious to one skilled in the art that product codes can be utilized.

Furthermore, since Goldhaber discloses a test, it would be obvious to one skilled in the art that the test can be multiple choice.

Furthermore, since Von Kohorn and Goldhaber disclose a test with correct answers, it would be obvious to one skilled in the art that variety of percentage of correct answers could be required to determine that the user paid sufficient attention.

Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made to add Goldhaber's rewarding a user for paying attention to content after testing the user to Von Kohorn's rewarding a user after testing and a user being presented content. One would have been motivated to do this in order to better determine that the user paid sufficient attention to advertising.

Response to Arguments

5. Applicant's arguments with respect to claims 1-21 have been considered but are moot in view of the new ground(s) of rejection.

Examiner notes that while specific references were made to the prior art, it is actually also the prior art in its entirety and the combination of the prior art in its entirety that is being referred to.

Conclusion

The following prior art made of record and not relied upon is considered pertinent to applicant's disclosure:

a. Eggleston (6,061,660) discloses online testing, correct answers, rewards, and presenting content.

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Arthur Duran whose telephone number is (703)305-4687. The examiner can normally be reached on Mon- Fri, 7:30-4:00.

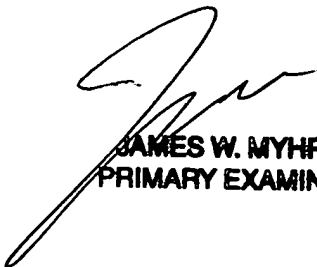
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If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Eric Stamber can be reached on (703)305-8469. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Ad

9/9/04


JAMES W. MYHRE
PRIMARY EXAMINER